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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,867	01/24/2001	Vittorio Castelli	D/99368Q (XER 2 0530)	3156

7590 10/06/2003

Patrick R. Roche
FAY, SHARPE, FAGAN, MINNICH & McKEE, LLP
1100 Superior Avenue, 7th Floor
Cleveland, OH 44114-2579

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,867

Applicant(s)

CASTELLI ET AL.

Examiner

Dan Colilla

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 14-17 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-8, 14-17 and 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 6, 14-15, 17, 20, 21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Osada et al.

With respect to claim, 1 Osada et al. discloses an apparatus including a paper guide 13, a biasing member 31 and a printing device 12. The biasing member is mounted upstream of the paper guide and biases against the paper guide 13 as shown in Figures 2-3 of Osada et al. Figure 3 also shows that the printing device extends beyond the paper guide 13 to a position on the upstream side of the paper guide 13. Additionally, by definition, an upstream side is in a direction opposite to the direction of travel of the paper path.

With respect to claims 14-15 and 17, Osada et al. discloses the structure as mentioned above with respect to claim 1 and further discloses that the printing device is substantially located over a position where the biasing member 31 and the paper guide meet as shown in Figure 3 of Osada et al.

With respect to claims 2 and 6, the paper guide 13 is a roller mounted perpendicularly to the paper path.

With respect to claim 20, by definition, an upstream side is in a direction opposite to the direction of travel of the paper path.

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With respect to claims 21 and 23, the printing area of printing device 12 is over the central axis of the printing guide 13 as shown in Figure 3 of Osada et al.

3. Claims 13, 16 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Okamura.

With respect to claim 13, Okamura discloses the claimed method for preventing deleting a trailing edge including the steps of biasing a biasing member 15 against a paper guide 11 on an upstream side of the paper guide 11, passing a piece of paper 18 between said biasing member and the paper guide 15 (Okamura, col. 2, lines 55-60), and moving a printing device 16 over the paper 18 (Okamura, col. 2, lines 46-48). Figure 2 of Okamura shows that the printing device 16 extends to a position beyond the paper guide 11 on the upstream side of the paper guide 11.

With respect to claim 16, Figure 2 shows that the printing device 16 is located over a position where the biasing member 15 and the paper guide 11 meet.

With respect to claim 22, Figure 2 shows that the printing device 16 has a printing area that extends over the central axis of the printing guide 11.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 3-4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osada et al., as applied to claims 1-2, 6, 14-15, 17, 20, 21, and 23 above, and further in view of Umeda.

With respect to claims 3 and 7, Osada et al. discloses the claimed apparatus except that it is not known to the examiner if the biasing member 31 is a pinch spring. However, Umeda teaches a printer with a pinch spring 79 biased against a paper guide 70 as shown in Figure 1 of Umeda. It would have been obvious to combine the teaching of Umeda with the apparatus disclosed by Osada et al. for the advantage of allowing the biasing member 31 to flex in a direction away from the paper guide so that various thicknesses of paper can be guided by the biasing member and paper guide through the printer.

With respect to claims 4 and 8, Figure 2 of Osada et al. shows the paper guide attached to the image forming device at one end with screws 43R and 43L and a second end biased against paper guide 13 such that the biasing member 31 is substantially aligned toward the paper path (to the extent that applicant's invention meets this requirement).

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (703) 308-2259. The examiner can normally be reached M-F, 8:30-5:30. Faxes regarding this application can be sent to (703) 746-4405.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (703)305-6619. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

September 17, 2003


Dan Colilla
Primary Examiner
Art Unit 2854